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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,030	01/09/2006	Annette S. Kim	21460P	7209
210 7590 07/30/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER HAYLIN, ROBERT H				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
07/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,030

**Applicant(s)**

KIM, ANNETTE S.

**Examiner**

ROBERT HAVLIN

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5, 7-9 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☒ Claim(s) 1, 2, 4, 6 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
- Paper No(s)/Mail Date 6/4/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

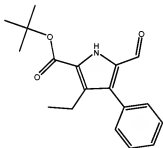
### DETAILED ACTION

**Status of the claims:** Claims 1-10 and 18 are currently pending.

**Priority:** This application is a 371 of PCT/US04/23425 (07/20/2004) which claims benefit of 60/489,699 (07/24/2003).

### *Election/Restrictions*

Applicant's election without traverse of group I (product of claims 1-10) in the reply filed on 12/03/2007 is acknowledged. Applicant also elected the following species (reading on claims 1, 2, 4, 6, 10, and 18):



No generic claim was found patentable, as detailed in the following rejections. Therefore, the claims are restricted to the elected species only and the remaining subject matter withdrawn. The restricted subject matter may be eligible for rejoinder if applicant responds in a manner that avoids all of the prior art.

### RESPONSE TO APPLICANT'S ARGUMENTS

#### *Double Patenting*

1. Claims 1, 2, 4, 6, and 10 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-5 of U.S. Patent No. 10/564347. Based on applicant's discussion of how the claims in the two

applications differ, **this rejection is withdrawn**. Specifically, the carboxyl group is at the 4' position in the '347 application versus the 2' position in the instant application.

***Claim Rejections - 35 USC § 102***

2. Claims 1, 2, 4, and 10 were rejected under 35 U.S.C. 102(b) as being anticipated by Cho et al. (in IDS: J.O.C. 1999, 64, p. 8048-8050). Applicant's amendment to the claims of changing C1-C10-alkyl to only tert-buty causes the claims to avoid the prior art. Therefore, **this rejection is withdrawn**.

***Claim Rejections - 35 USC § 112***

Claims 1, 2, and 10 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's amendment to the claims now makes them definite by the recitation of the specific substituents. Therefore, **this rejection is withdrawn**.

**NEW REJECTIONS**

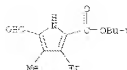
***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

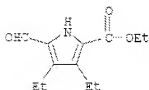
4. Claims 1, and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (Journal of Organic Chemistry (1984), 49(24), 4602-9).



The reference teaches the following compound: which anticipates the claims when R1 is t-butyl; and R2 is Methyl.

5. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Eisner et al. (STN Abstract of Journal of the Chemical Society (1957) 733-9).

The reference teaches the following compound anticipating the claim:



### ***Claim Objections***

The pending claims are objected for reading on non-elected subject matter as a result of the restriction to the elected species ONLY. Claims 2, 3, and 10 are objected to for being dependent on a rejected base claim.

### ***Conclusion***

No claims are in condition for allowance. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/

/Kamal A Saeed, Ph.D./